



**UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/257,879	03/02/99	MCGREDY	S 33947/VGG/R2

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HM22/0214

EXAMINER	
LOCKER, H	
ART UNIT	PAPER NUMBER
1661	5

DATE MAILED:


02/14/01

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

**A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET
TO EXPIRE 2 MONTHS, DAYS FROM THE DATE OF THIS LETTER.**

(see attached)


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661

09/257879
PTOL 90 (REV. 10/80)

NOTE: Applicant's response, filed November 14, 2000, has effectively addressed the issues raised in the Office action mailed September 18, 2000.

35 U.S.C. 102

The claimed rose cultivar 'Macsupbow' is described in Breeder's Right application number NZ PBR ROS573 which was filed on May 16, 1996 and published July 14, 1996, more than one year prior to the filing date of the instant application for United States Plant Patent. Plant Breeder's grant registration number 1363 was granted in New Zealand on May 20, 1998, and said grant was published on July 14, 1998, such being prior to the filing date of the instant application. The published grant and application are each "printed publications" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226; 210 USPQ 790, 794 (CCPA 1981). See also MPEP section 2128.

For example, UPOV publishes the application number, grant number, date of publication, species of plant, and variety denomination for PBR certificates, and copies of the grant and application are obtainable through the Plant Variety Rights Journal. Thus, information regarding the claimed cultivar, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

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A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokora cultivar disclosed in the cited publications.").

While the publications cited above disclose the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the published application, combined with the knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Electronic and paper search within the Office has not revealed any evidence that the claimed plant was on sale anywhere in the world. However, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties (i.e. the public) free of charge. Since the inventor and the assignee (if applicable) of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information per the attached Requirement for Information Under 37 CFR 1.105.

A requirement for information under 37 CFR 1.105 is attached. This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months from the mailing date of this communication. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

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Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campell, can be reached at 703-308-4205.

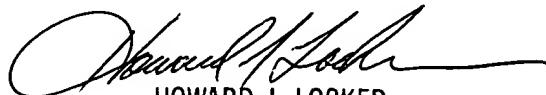
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703-308-0196.

TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to this Group via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is 703-308-4242 or 703-305-3014.

Howard J. Locker/hjl

February 05, 2001


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT *1661*

REQUIREMENT FOR INFORMATION UNDER **37 CFR 1.105**

Applicant and the assignee (if applicable) of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'Macsupbow', was publicly available prior to the filing date of the instant application.

In response to this requirement, please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. Also, please provide copies of the published application, published proposed denomination, and published Breeder's Right grant. The Office does not maintain a collection of Breeder's Rights documents and they are not readily obtainable electronically. It is reasonable to expect that Applicant or assignee (if applicable) can readily obtain the requested documents and information.

The fee and certification requirement of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

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Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or not readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

1. The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

"The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted."

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se, and which distinguish same over related or similar known cultivars and antecedents.

More specifically:

A. During a search of UPOV-ROM, the following "hits" on a rose cultivar named 'Macsupbow' were found: NZ PBR ROS573 and ZA PBR 02519.

While these earlier filed foreign documents would appear to be drawn to the same plant given the limited information available on UPOV-ROM, it cannot conclusively or positively be determined that such is the case.

Applicant must substantively address and obviate this issue responsive to this Office action (so as to provide as complete a description of the plant as is reasonably possible) by one of the two avenues mentioned below:

(1) If the above are indeed drawn to the same plant as is presently described and illustrated (i.e. the instant plant), such needs to be positively and clearly acknowledged in applicant's comments responsive to this Office action. In the alternative, applicant could file a substitute declaration incorporating these earlier prior foreign filings so as to clarify the issue should such be found to be the case, even though foreign priority is not being claimed;

(2) If either of the above earlier filed referenced foreign documents refer to a different plant, it would be necessary for applicant to take corrective action relative to the cultivar name of the plant presently described and illustrated (i.e. the "instant" plant) such as by correcting same, as reuse of the cultivar name 'Macsupbow' would then be inadmissible under at least Article 48, Article 50, and Article 51 of the ***INTERNATIONAL CODE OF NOMENCLATURE FOR CULTIVATED PLANTS-1980***.

As plant names are associated with and used to identify particular plants and are therefore descriptive, for a United States Plant Patent to properly issue, the cultivar name set forth in the specification must be acceptable.

B. The recitation of "candelabras" at line 27 of page 1 should be reviewed for accuracy, as such does not appear to be a term readily recognized as meaningful in the art.

C. The recitation "clothed in" as recited at line 13 of page 2 should be reviewed for accuracy, as such does not appear to be a normal recitation in the art when addressing foliage.

D. The recitation "and glandular bloom" as recited at line 30 of page 4 is not understood. What is intended?

The above listing may not be comprehensive. Applicant should carefully review the disclosure and import into same any additional or corrected information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is being sought.

2. The claim is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant, for the reasons set forth in paragraph 1 above.

3. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campell, can be reached at 703-308-4205.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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Howard J. Locker/hjl
September 18, 2000


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661